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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/084,755

Filing Date: February 25, 2002

Appellant(s): BENOIT, HERVE

MAILED

AUG 10 2007

Technology Center 2100

Terry W. Kramer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/24/2007 appealing from the Office action

mailed 12/04/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,115,821	NEWBY	9-2000
6,912,513	CANDELORE	6-2005
5,029,207	GAMMIE	7-1991

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US 2002/0001383 A1 KASAHARA 1-2002

"Functional Model of a Conditional Access System" EBU Review Technical European
Broadcasting Union, No 266, Page 71 12-1995

EP 1168137 Della Valle 6-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 5, 6, 8, 9 and 10 are rejected under 35 U.S.C. 35 U.S.C. 103(a) as being
unpatentable over Newby US 6,115,821 in view of Candelore US 6,912,513 in view of
Kasahara US 2002/0001383.**

As per claims 1, 10 Newby teaches a system to process and decoded signals in order to convert them into output stimuli understood by a user, (Col 3 lines 5-17). Newby teaches use of a decoder, (Col 5 lines 28-35). Newby teaches an output device, (Col 4 lines 1-10). Newby teaches descrambling means activated by an enabling signal, (Col 6 lines 1-20). Newby teaches descrambling means comprise hardware activated by said enabling

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signal, (Col 5 lines 43-60). Newby fails to teach decompressing. Newby fails to teach transferring a conditional access software program to descrambling means.

Candelore teaches a decoder that decompresses received data (Col 4 lines 1-5).

It would have been obvious to one of ordinary skill in the art to use the compressing techniques of Candelore with the conditional access system of Newby because compressed data takes less space and is thus faster to transport.

Candelore does not teach transferring a conditional access software program to descrambling means.

Kasahara teaches sending from a sender to a receiver a decryption program, and a key for use with the decryption program, [0042].

It would have been obvious to use the decryption program of Kasahara with the previous Newby-Candelore system because it provides a stronger crypto system thus enhancing security.

As per claim 3, Newby teaches the enabling means are incorporated in the decoder, (Col 5 lines 21-24, Col 6 lines 33-36).

As per claims 5, and 6 Newby teaches a smart card interfacing with the decoder to provide the enabling means via an enabling signal, (Col 7 lines 20-34).

As per claim 8, Newby teaches use of a smart card, (Col 7 lines 27, 61).

As per claim 9, Newby teaches where enabling means are provided through real-time data exchange, via multiple means of communication (Col 3 lines 40-60).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newby US 6,115,821 in view of Cadelore US 6,912,513 in view of Kasahara US 2002/0001383. in view of Gammie US 5,029,207.

As per claim 2, the previous Newby-Cadelore-Kasahara combination does not teach that the descrambler is in the decoder. Gammie teaches that the descrambler is in the decoder, (Fig 2).

It would have been obvious to one of ordinary skill in the art to use the method of Gammie with the system of Newby-Cadelore-Kasahara because by combining the descrambler with the decoder the system is smaller and more efficient.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newby US 6,115,821 in view of Cadelore US 6,912,513 in view of Kasahara US 2002/0001383. in view of “Functional Model of a Conditional Access System” EBU Project Group.

As per claim 4, the previous Newby-Cadelore-Kasahara combination does not teach where the decoder is incorporated into the output device, EBU teaches that the decoder may be part of an output device, (pg 71, 4.1 Paragraph 2). It would have been obvious to

one of ordinary skill in the art to integrate the system of Newby-Candelore-Kasahara with the output device of EBU to make the system smaller and more user friendly.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newby US 6,115,821 in view of Candelore US 6,912,513 in view of Kasahara US 2002/0001383. in view of Della Valle EP 1168137A1

As per claim 7, the previous Newby-Candelore-Kasahara combination teaches a smartcard memory for storing protected information, but fails to teach a detachable smart card reader.

Della Valle teaches a detachable smart card reader capable of interacting with a device and a smartcard, [0011], [0023], Fig 1.

It would have been obvious to one of ordinary skill in the art to use the portable smart card reader of Della Valle with the system of Newby-Candelore-Kasahara to enhance the security to prevent unwanted users from accessing the system.

(10) Response to Argument

The applicant argues against the motivation used to combine references for the 35 U.S.C. 103(a) rejections of claims 1, 2, 4, 7, and 10.

A) As for the Rejection of claims 1, and 10 the applicant argues that the examiners motivation uses impermissible hindsight. Appellant admits that a reference need not

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expressly teach that a disclosure contained therein should be combined with another, but argues the combination must be clear and particular. The Appellant argues that the references in the instant case are not clear and particular. Appellant argues with regards to claims 1, and 10 that the Examiners motivational statement to combine Newby, US 6,115,821, Candelore US 6,912,513 and Kasahara US 2002/0001383 are separate and unsubstantiated motivations.

As per claims 1, and 10 the Examiner argues that with regard to improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, all of the references the examiner has used, Newby, Candelore, and Kasahara are of analogous art of electronics, and related security. As the examiner stated in the

Final rejection one of ordinary skill would have been motivated to combine Newby, Candelore, and Kasahara.

Candelore's compression techniques to increase available space and transport times. A compressed file has a lesser size than an uncompressed file, and thus can be sent over a network more quickly. One of ordinary skill in the art would recognize this benefit and be motivated to combine Newby with Candelore.

Kasahara teaches a distribution method for a decryption program, and a key. This decryption program is sent by a distribution station, so that Kasahara ensures that the user can decrypt what was sent to them, and ensures that only the users who are sent the decryption program can access the encrypted data. This restriction of the decryption program further enhances the cryptographic system. One of ordinary skill in the art would recognize the benefit of this type of control, and be motivated to combine with Newby and Candelore.

Furthermore, the recent decision in *KSR v. Teleflex* states "person of ordinary skill in the art is also a person of ordinary creativity, not an automaton," and by adopting "[r]igid preventative rules that deny factfinders recourse to common sense" in its efforts to avoid "hindsight bias" the Court may have erred. The Court noted that "[w]hat matters is the objective reach of the claim," and whether there was at the time of the invention "an obvious solution" for a "known problem."

B) As for the Rejection of claim 2 the Appellant argues that the examiners motivation uses impermissible hindsight. Appellant admits that a reference need not expressly teach that a disclosure contained therein should be combined with another, but argues the combination must be clear and particular. The Appellant argues that the references in the instant case are not clear and particular.

With regard to claim 2, the Examiner will mostly rely on his argument made for Claims 1, and 10 shown above in section A.

Additionally, one of ordinary skill in the art would have been motivated to combine Gammie US 5,029,207 with the previous Newby-Candelore-Kasahara system. Gammie is of an analogous art, security related. Gammie merely incorporates the descrambler into the decoder. The potential space and cost savings of incorporating the descrambler into the decoder, rather than using an additional, separate circuit, would motivate one of ordinary skill in the art to add Gammies decoder/descrambler into the Newby-Candelore-Kasahara system.

C) As for the Rejection of claim 4 the Appellant argues that the examiners motivation uses impermissible hindsight. Appellant admits that a reference need not expressly teach that a disclosure contained therein should be combined with another, but argues the combination must be clear and particular. The Appellant argues that the references in the instant case are not clear and particular.

With regard to claim 4, the Examiner will mostly rely on his argument made for Claims 1, and 10 shown above in section A.

Additionally, one of ordinary skill in the art would have been motivated to combine the “Functional model of a conditional access system” EBU Project Group with the previous Newby-Candelore-Kasahara system. EBU is of an analogous art, security related. EBU teaches incorporating the decoder in the output device. As EBU states, it should be easy to gain access to broadcasts, requiring the minimum of equipment (page 71).

Incorporation of the decoder into the output device ensures this minimum of equipment. It would have been obvious to one of ordinary skill in the art to integrate the system of Newby-Candelore-Kasahara with the output device of EBU to ensure the minimum of equipment and maximum ease for the consumer.

D) As for the Rejection of claim 7 the Appellant argues that the examiners motivation uses impermissible hindsight. Appellant admits that a reference need not expressly teach that a disclosure contained therein should be combined with another, but argues the combination must be clear and particular. The Appellant argues that the references in the instant case are not clear and particular.

With regard to claim 7, the Examiner will mostly rely on his argument made for Claims 1, and 10 shown above in section A.

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Additionally, one of ordinary skill in the art would have been motivated to combine Della Valle EP 1168137 with the previous Newby-Candelore-Kasahara system. Della Valle is of an analogous art, security related. While the Newby-Candelore-Kasahara system does teach a smart card reader to check a users smart card for storing information (Figure 4; 75, of Newby) it does not teach the reader of the smart card may be detached. The reader is restricted and built into the Newby-Candelore-Kasahara system. Della Valle teaches a smart card reader that may be used in a variety of systems. In addition to versatility offered by Delle Valle's detachable smart card reader, the reader also allows a user to remove the smart card reader from the Newby-Candelore-Kasahara system thus preventing other users from using their smart cards. This allows a user to add an additional layer of security, hence motivating one of ordinary skill in the art to add Della Valle to Newby-Candelore-Kasahara.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Christopher J. Brown

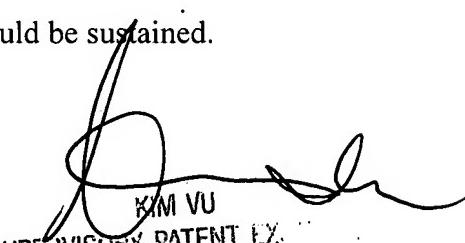


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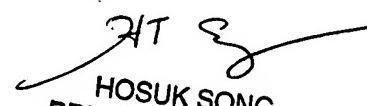
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